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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,204

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Kent Nyman

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EXAMINER

BASHAW, HEIDI M

ART UNIT

PAPER NUMBER

3732

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,204	<b>Applicant(s)</b> NYMAN, KENT	
	<b>Examiner</b> HEIDI M. BASHAW	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Invo EP 0 314 657 in view of Keogh, Jr. et al. 2,228,169 (Keogh).

3. Re claim 1, Invo teaches a mirror 4 and a suction device (col. 4, ll. 19-20) having an inlet through which liquid is sucked by the suction device and the reflecting surfaces of the mirror being adapted to be at least partially cleaned by liquid flowing thereacross (col. 4, ll. 30-35).

4. Invo does not teach the reflecting surface of the mirror being passed through by an opening.

5. Keogh teaches the reflecting surface of the mirror being passed through by an opening as illustrated in fig. 3 (col. 2, ll. 6-8).

6. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order to provide more freedom of movement and not create a blind spot as taught by Keogh (col. 1, ll. 32-34).

7. Re claims 2 and 14, Invo does not teach the mirror is prevented from rotating during use.

8. Keogh teaches the mirror is prevented from rotating during use (col. 2, ll. 40-41).

9. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order allow the user to direct the suction in a desired direction with one hand leaving the other hand free as taught by Keogh (col. 3, ll. 61-62, 70-71, col. 4, ll. 1-3).

10. Re claim 3, Invo teaches the mirror is arranged to suck up all liquid intended to be removed (col. 4, ll. 31-35).

11. Re claim 4, Invo does not teach the mirror extends in the manner of a flange away from the inlet.

12. Keogh teaches the mirror extends in the manner of a flange away from the inlet as illustrated in fig. 3.

13. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order to provide more freedom of movement and not create a blind spot as taught by Keogh (col. 1, ll. 32-34).

14. Re claims 5 and 16-17, Invo does not teach the mirror forms an integrated part of the instrument, however, it has been held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice (*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) MPEP 2144.04 V. B.).

15. Re claims 6 and 18, Invo teaches the mirror removably attachable to the instrument as illustrated in fig. 4 (col. 3, ll. 48-49).

16. Re claim 8, Invo teaches the suction device comprises a tubular suction nozzle (col. 4, ll. 19-20, 51-53).

17. Invo does not teach the opening in the mirror forming a mouth and the suction nozzle is curved.

18. Keogh teaches the opening in the mirror forming a mouth and the nozzle is curved as illustrated in fig. 3.

19. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order to provide more freedom of movement and not create a blind spot as taught by Keogh (col. 1, ll. 32-34).

20. Re claims 9 and 19, Invo teaches the mirror is removably attached to the suction device by a frictional coupling arrangement (col. 3, ll. 48-49).

21. Re claims 10 and 20, Invo teaches the mirror is removably attached to a seat in the suction device by a holder as illustrated in fig. 5.

22. Re claim 11, Invo teaches a mirror 4 comprising a sleeve 6 adapted to couple the mirror to a suction device and a reflecting surface being adapted to at least be partially cleaned by liquid sucked by the suction device (col. 4, ll. 30-35).

23. Invo does not teach a reflecting surface being passed through by an opening.

24. Keogh teaches a reflecting surface being passed through by an opening as illustrated in fig. 3 (col. 2, ll. 6-8).

25. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order to provide more freedom of movement and not create a blind spot as taught by Keogh (col. 1, ll. 32-34).

26. Re claim 12, Invo teaches the suction device includes an inlet and is for a dental instrument (col. 4, ll. 19-20, 51-54).

27. Invo does not teach the opening forms the mouth of the inlet.
28. Keogh teaches the opening forms the mouth of the inlet as illustrated in fig. 3.
29. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order to provide more freedom of movement and not create a blind spot as taught by Keogh (col. 1, ll. 32-34).
30. Re claim 13, Invo teaches a dental instrument comprising the suction device including an inlet (col. 4, ll. 19-20, 51-54).
31. Invo does not teach the opening forms the mouth of the inlet.
32. Keogh teaches the opening forms the mouth of the inlet as illustrated in fig. 3.  
  
It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order to provide more freedom of movement and not create a blind spot as taught by Keogh (col. 1, ll. 32-34).
33. Re claim 15, Invo teaches the mirror is arranged to suck up, through the sleeve all liquid intended to be removed (col. 51-54).
34. Re claims 21-22, Invo does not teach the diameter of the opening matches the diameter of the suction device.
35. Keogh teaches the diameter of the opening matches the diameter of the air supply device as illustrated in fig. 3.
36. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh in order to create a tight connection between the two elements.

37. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Invo EP 0 314 657 in view of Keogh, Jr. et al. 2,228,169 (Keogh) further in view of Hukuba 4,212,105.

38. Re claim 7, Invo in view of Keogh does not teach the mirror is of a magnifying kind.

39. Hukuba teaches the mirror is of a magnifying kind (col. 9, l. 41).

40. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Invo in view of Keogh further in view of Hukuba in order to allow of inspection of the minutest details as taught by Hukuba (col. 9, ll. 42-43).

### ***Response to Arguments***

1. Applicant's arguments filed February 6, 2008 have been fully considered but they are not persuasive. Applicant argues that the combination of Invo and Keogh is not proper because the intended purpose. Keogh was used in combination with Invo to teach an opening through the reflecting surface of the mirror. Keogh teach air being able to flow through the instrument out through the opening in the mirror (col. 1, ll. 1-9), therefore in combination with Invo which teaches a mirror and a suction device (col. 4, ll. 19-20) the combination is operable because the device taught by Invo and Keogh are both capable of air being able to flow through the instrument. It is also noted that it would have been obvious to one having ordinary skill in the art to modify Invo in view of Keogh, to include an the opening through the reflecting surface, since is has been held that the rearranging parts of an invention involves only routine skill in the art (*In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) MPEP 2144.04 VI C).

2. In response to applicant's argument that the opening taught by Invo teaches an equally distributed suction over the mirror and that the aperture taught by Keogh is a very small one that would make Invo inoperable it is noted that the hole in the center of the reflecting surface taught by Keogh would also provide an equally distrusted suction when combined with Keogh, since the opening in the center of the mirror. In regards to the size of the aperture, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the size of the aperture since it has been held to be within the general skill of a worker in the art to change the size of an element (*In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984) MPEP 2144.04 IV A).

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI M. BASHAW whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Heidi Bashaw**  
**Examiner**  
**Art Unit 3732**

**/John J Wilson/**  
**Primary Examiner**  
**Art Unit 3732**

HMB

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